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Supreme Court of the United States

October Term, 1959

No. [redacted] 369

BERNARD GLAGOVSKY,
PETITIONER,

v.

BOWCRAFT TRIMMING CO. ET AL.,
RESPONDENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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September 2, 1959

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PETITIONER,

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BOWCRAFT TRIMMING CO. ET AL.,

RESPONDENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

The petitioner, Bernard Glagovsky, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit, dated and entered in the above-entitled case on June 5, 1959 (R. 213).

A certified transcript is furnished herewith of the record in the above case, including the proceedings in the said Court of Appeals, in compliance with Rule 21 of the Rules of this Court.

OPINIONS BELOW

The opinion of the District Court for the District of Massachusetts, Judge Aldrich (R. 188), is reported at 164 F. Supp. 265, and is printed as Appendix A hereto.

The opinion of the Court of Appeals for the First Circuit (R. 204), affirming the decision of the District Court, though upon different grounds, is reported at 267 F. 2d 479, and is printed as Appendix B hereto.

JURISDICTION

The judgment of the Court of Appeals was dated and entered June 5, 1959 (R. 213).

The jurisdiction of this Court to review the above-mentioned decision of the Court of Appeals is invoked under the provisions of 28 U.S.C., Section 1254(1).

Some of the previous decisions of this Court, bearing on jurisdiction, and specifically related to the Questions Presented hereinafter, are as follows:

This Court will grant certiorari:

1. To construe the patent laws:

Wine Railway Appliance Co. v. *Enterprise Railway Equipment Co.*, 297 U. S. 387.

Sola Electric Co. v. *Jefferson Electric Co.*, 317 U. S. 173, 175.

Halliburton Oil Well Cementing Co. v. *Walker*, 329 U. S. 1, 2-3.

United Carbon Co. v. *Binney & Smith Co.*, 317 U. S. 228, 229.

2. To resolve questions of conflict between decisions of different Courts of Appeals:

Wine Railway Appliance Co. v. *Enterprise Railway Equipment Co.*, supra.

U. S. Industrial Chemicals, Inc. v. *Carbide & Carbon Chemicals*, 315 U. S. 668, 669.

Note. After this petition was ready for final printing, the plaintiff learned of the Petition for Certiorari, No. 361, *Stoffel Seals Corporation* v. *E. J. Brooks Company*, which raises issues, some of which are similar to those raised hereunder paragraphs 1 and 2 of this section.

QUESTIONS PRESENTED.

In the case of an invention relating to an admittedly new combination of old elements, which combination had previously, for many years, escaped all prior workers in the art, that has now replaced all prior such combinations and also prior methods of manufacturing the same, including methods that involved danger to the operator, that were costly, and that produced inferior products:

Question I

May a patent covering that combination, within the meaning of Section 103 of the Patent Act of 1952, be invalidated upon the ground that the various elements thereof are old, though the combination, "as a whole", is admittedly new?

Question II

In the absence, as the record shows, of the person specified in the said Section 103, as "having ordinary skill in the art to which said subject matter pertains", to whom the admittedly new combination "as a whole", was "obvious", may a Court, upon the ground that the combination "as a whole", after it has been made, turns out now to be "simple", substitute itself as the person to whom the said invention "as a whole" would have been "obvious at the time the invention was made"?

Question III

May a Court find justification for such substitution by reason of the manner in which the problem was solved?

Note. The issues raised by Questions I and II are stated also on pages 20-21 of the Stoller Steel Corporation Petition for Certiorari, No. 361, *supra*.

STATUTE INVOLVED

Title 35, Section 103 of the Patent Act of 1952, is quoted in Appendix C.

SUMMARY STATEMENT OF THE MATTERS INVOLVED

This is an action for infringement of all five claims of United States Patent No. 2,792,656 (R. 7) for an "Ornamental Stud and Ornament Dangling Therefrom", issued to the plaintiff on May 21, 1957.

It is frequently stated that the day of the lone inventor is over, and that our inventions are now all made by large research institutions. The plaintiff presents himself before the Court in disproof of this statement. He alone made the invention of the patent in suit, and he alone placed it upon the market, through the medium of his small company (R. 118-119). The invention had so great merit that it immediately put an end to many years of struggles of the art, and it has now displaced all devices of the kind previously in use.[1]

The memory of one of the affiants fixes the time of the commencement of these struggles as at least just after the First World War (R. 124); and, according to the finding of the District Court (R. 188, page 17, *infra*), the period goes back even very much longer, to the time of Mother Goose.

Of the many prior art proposals for solving this problem, the Court of Appeals mentions only two (the two that the specification of the plaintiff's patent (R. 9, column 1, lines 27 to 42) admits to be the best that the art was able to produce

[1] Attention is invited to the quotation from George E. Frost's "The Patent System and The Modern Economy, *infra*, page 12.

prior to his invention). The Court of Appeals agrees that one of these two prior-art proposals was subject to a "defect", and the other to a "disadvantage"; which disadvantage, moreover, was attended with danger to the fingers and thumb of the shoemaker, at the shoe factory."

As soon as the plaintiff's invention appeared on the market, however, these struggles all ceased. All prior proposals for solving this problem became immediately obsolete, for the invention promptly superseded them. In the words of the Court of Appeals, therefore, the plaintiff's invention provided a "meaningful contribution to the art of making shoes" that "may well be useful and ingenious"; in consequence of which "The defendants' infringement is freely admitted".

These facts would appear to spell out all the elements of an important invention. It is brand new. There has always been a demand for it. All prior attempts to solve the problem ended in failure and have become displaced, wherefore the plaintiff's competitors are now competing with him by manufacturing and selling the exact identical product that his own brain conceived.

The District Court and the Court of Appeals (pages 17, 20 *infra*) both found the invention, however, to be "simple"; and

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The description, by the Court of Appeals, that "Moreover operators were likely to have their fingers pinched in the process" is an understatement. The operator's fingers and thumb were actually *pierced* by descending sharp tools that pierced the flesh and the bone of the fingers and thumb (R. 131, 134, 153). The Court of Appeals was probably confused by Pope Appliance Corporation v. Spanuk Paper Pulp and Board Mills Ltd (1929), Reports of Patent, Design, Trade Mark, And Other Cases, vol. 46, page 25, at page 55, where the Court remarked:

> "The first and obvious observation is that, if it required no invention, it was very odd that people were allowed to go on pinching their fingers for thirty-five years."

In the present case, it was more odd still that the operators should have been allowed, for so many years, to go on piercing their fingers and thumbs with descending sharp instruments.

therefore (contrary to prior judicial holdings, see Appendix D), "obvious".[3]

The District Court said that "*I* am unable to perceive invention", and "it does not seem *to me* to require inventive genius" (italics supplied). This was because it was old (R. 189, p. 18, *infra*)

> "* * * to add a hook to a breast pin from which to suspend doo-dads, or eyeglasses, or if you are an aborigine, to make a hole in your nasal cartilage from which to hang a ring."

Ignoring, therefore, the plain commandment of Section 103 of the Patent Act of 1952, that the test of invention shall be what may be obvious, *not* to a Court, *after the event*, but "to a person having ordinary skill in the art to which said subject matter pertains", "at the time the invention was made", the District Court granted the defendants' motion for summary judgment and denied the plaintiff's.

The Court of Appeals affirmed; but only by again substituting *itself* for the person prescribed by the said Section 103, to whom the invention is required to be "obvious", "at the time the invention was made". Repeatedly, the Court of Appeals said: "Glagovsky's device impresses *us* as so lacking in invention * * * it still does not seem to *us* to exhibit 'that elusive something known as invention' * * * it does not seem to *us* that even in the light of the plaintiff's commercial success it can be said that the plaintiff's contribution * * * can be called an invention * * *" (italics supplied). To "*us*", the Court of Appeals, the plaintiff's accomplishment was "no more than the sort of advance to be expected from any

[3] It is because of the very simplicity of the invention, indeed, and because it is therefore understandable without the aid of expert testimony, that the parties submitted the case for adjudication by motions for summary judgment, supported by affidavits, depositions and prior patents. There being no dispute as to the infringement, the only issue raised by these motions for summary judgment was that of invalidity.

ordinarily skillful mechanic conversant with any of the arts involved."

The Court of Appeals appeared not to realize that it was speaking here from hindsight, and that the very best that could be produced by the "ordinarily skillful mechanics" from which it "expected" the invention in suit, were the two prior-art defective and disadvantageous proposals referred to on pages 4 and 5 *supra*.[1]

The Court of Appeals was only following its own prior holdings, *Wasserman* v. *Burgess & Blacher Co.*, 1954, 1 Cir., 217 F. 2d 402, 404, *Hawley Products Co.* v. *United States Trunk Co.*, 1958, 1 Cir., 259 F. 2d 69, 72, to the effect that the said Section 103 "merely codified the existing decisional law".

In *Lyon* v. *Bausch & Lomb Optical Co.*, 1955, 2 Cir., 224 F. 2d 530, certiorari denied, 350 U. S. 911, rehearing denied, 350 U. S. 955, however, Judge Learned Hand held that Section 103 has restored the law to what it used to be "twenty or thirty years ago" (at the bottom of the second column of page 534), as originally laid down by *Hotchkiss* v. *Greenwood*, 1850, 11 How. 248, 267. It was the hope of Congress by thus restoring the law to what it used to be "twenty or thirty years ago", that the confidence of inventors would become re-established, and the progress of the useful arts become thereby promoted.

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[1] Incidentally, it may be mentioned that these [illegible] perforated nasal cartilages, and the said two defective and disadvantageous prior-art devices were not among the instances of prior knowledge set up in the answer (R. 14, 15), as required by Section 282 of the Patent Act of 1952, quoted in Appendix C to this brief, of the investigations of the novelty of this invention, two by experienced attorneys investigating in behalf of the plaintiff (R. 177-178, 203-204), two by the Patent Office Examiners (R. 197, 204), and at least one by the attorneys for the defendants themselves, it never occurred to any of the attorneys for either the plaintiff or the defendants, or to the Patent Examiners in the Patent Office, that either the prior art cited by the defendant in the District Court or that relied upon by the Court of Appeals had any bearing whatever upon the problems that led to the making of the invention.

At the hearings before the Subcommittee No. 3 of the Committee on the Judiciary, House of Representatives, 82nd Congress, First Session, on H. R. 3760 (the immediate predecessor of H. R. 7794 which, with amendments, became enacted into the Patent Act of 1952), A Bill To Revise And Codify The Laws Relating To Patents and The Patent Office, and To Enact Into Law Title 35 of the United States Code Entitled "Patents", on June 13, 1951, Mr. P. J. Federico, Examiner-in-Chief, United States Patent Office, page 38, testified as follows with respect to the then proposed Section 103:

> The language paraphrases language which has been used quite often in the decisions of the courts, and the section was added with the thought that having it expressed would be a good thing to do rather than having it deductible from a large number of decisions of the courts. This section may *introduce more definiteness* and *have some stabilizing effect*, and *may prevent great departures which have appeared in some cases* (Italics supplied).

The same Mr. Federico is the author of the "Commentary on the New Patent Act", preceding the text, 35 U. S. C. A., West Edition, pages 1-70. On pages 22-23 of the Commentary, *he said*:

> While it is not believed that Congress intended any radical change in the level of invention or patentable novelty, nevertheless it is believed that some modification was intended in the direction of moderating the extreme degrees of strictness exhibited by a number of judicial opinions over the past dozen or more years; that is, that some change of attitude more favorably to patents was hoped for. This is indicated by the language used in section 103 as well as by the general tenor of remarks of the Committees in the reports and particular comments. Weight should be given to the terms used in the section since a variety of expressions used in decisions were available, including some stated with an extreme degree of strictness, which could have been used as the model for the phraseology to be adopted, but the lan-

guage selected was of the more moderate variety. The Committee report, in the general part, states that the section "should have a stabilizing effect and minimize great departures which have appeared in some cases"; the departures of which complaint has been made in the recent past are all departures in the direction of greater strictness and hence these would be what the report indicates should be minimized. Early decisions under the new act, however, have taken the view that no change was intended * * * It may be considered still too premature to conclude from the remarks in decisions thus far rendered that new section 103 may not have the influence on the courts which was anticipated by its enactment.

Judge Learned Hand's *Lyon* decision, which appeared after this Commentary of Mr. Federico was published, shows "that new section 103" has, at last, produced "the influence on the courts which was anticipated by its enactment"; in that some courts have followed Judge Hand's decision in the *Lyon* case. *L-O-F Glass Fibers Company* v. *Watson*, 1955, C. A. D. C., 228 F. 2d 40, 47, and note 14. *R. M. Palmer Company* v. *Luden's, Inc.*, 1956, 3 Cir., 236 F. 2d 496, 498, 500. *Brown* v. *Brock*, 1957, 4 Cir., 240 F. 2d 723, 728.

Other courts, however, have not followed this decision of Judge Learned Hand. The Court of Appeals for the First Circuit has declined to do so in the several cases cited above. As stated by Judge Lumbard, dissenting, *E. J. Brooks Company* v. *Stoffel Seals Corporation*, 1959, 2 Cir., 266 F. 2d 811, at page 847, "Only the First Circuit appears to have considered and rejected it".

ARGUMENT IN SUPPORT OF THE ALLOWANCE OF THE WRIT

The invention covered by the five claims of the patent is sufficiently well described in the second paragraph of the opinion of the Court of Appeals. For present purposes, however, it may be well to consider claim 1 alone. This claim i

(R. 10) covers "as a whole" (Section 103 of the Patent Act of 1952), a combination of two elements. One of these elements is a multi-pronged, ornamental nailhead stud. The other element is a ring or hook integral therewith. The integral ring is shown at 8, Fig. 1 (R. 7) of the drawings of the patent, and the integral hook is shown at 6, Fig. 2. An additional ornament (additional to the nailhead stud itself) is caused to dangle freely from the integral ring or hook (instead of being rigidly attached thereto), as shown at 10, and as described in claim 4 (R. 10), in order to impart life to the shoe as the wearer walks or dances.

With respect to Question 1, the District Court and the Court of Appeals for the First Circuit have both read completely out of the statute the words "as a whole". Both courts have agreed that the combination, "as a whole", is new. The District Court, for example, said that "No such article has ever previously been patented or manufactured for this precise purpose" (R. 188, page 17, *infra*); and the Court of Appeals also found the combination to be new, (page 21, *infra*): "nail head studs having a peripheral, integral ring, or hook for suspending the dangling ornament were not known prior to the disclosure of Glagovsky's patent." The District Court and the Court of Appeals have found to be old only the *elements* of the combination, namely, the nailhead studs and the hooks or rings.

It has already been stated that the District Court found the hooks to be old in the art of breast pins and the rings to be old in the art of perforated nasal cartilages. The Court of Appeals similarly found (R. 21) the rings to be old in the earring shown in the Northrup patent No. 119,530, of 1871 (R. 93). These are all from arts entirely foreign to the shoe making art. The law relating to non-analogous arts is touched upon briefly in Appendix D.

The fact, therefore, is that though the District Court and the Court of Appeals both found the elements of the admittedly new combination to be individually old, in *different arts*, they have not found the combination of the invention "as a whole" to be old in *any* art.

The expression "as a whole" was put into the statute for a purpose, to emphasize the holdings of this Court. *Bates v. Coe*, 1878, 98 U. S. 31, 48. *Tuttle v. Buck*, 1879, 101 U. S. 647, 660. *Parks v. Booth*, 1880, 102 U. S. 96, 103. The law is treated more fully, commencing with page 147 of Walker on Patents, Deller's Edition, 1937, Vol. I, Ch. III, "Invention".

With respect to Question II, in *Application of Raff and Dykeshire*, 1958, C. C. P. A., 256 F. 2d 590, 598, the Court interpreted Section 103 as laying down the test that

> * * * what amounts to patentable "invention" * * * is simply whether the difference between what is claimed *and the prior art* would have been obvious to one of ordinary skill in the art at the time the invention was made. (Italics the Court's).

not whether the invention, through hindsight, may seem obvious to a Court. It has been repeatedly held that the simplicity of an invention "should not blind us as to its merit". *Diamond Rubber Company of New York v. Consolidated Rubber Tire Company*, 1911, 220 U. S. 428, 434; *Goodyear Tire and Rubber Co., Inc. v. Ray-O-Vac Company*, 1944, 321 U. S. 275, 279.

In connection with these Questions I and II, in order for the attorneys for the petitioner to say that they are in full agreement with the interpretation of the Patent Act of 1952 on pages 20-21 of Stoffel Seals Corporation's Petition for Certiorari, No. 361, *supra*, if this Court should disagree with that interpretation, the facts of the present case would establish the conclusion that the plaintiff made an invention.

With respect to Question III, the Court of Appeals said that, though "The plaintiff solved these problems",

> "But he did so by adopting a device which, with only a mechanic's changes, had long been in use in the allied arts. . . ."

What of it? What did it matter *how* the plaintiff solved this long-existent problem, so long as he *did* solve it, and so long as many others were unable to solve it? The same Section 103 of the Patent Act of 1952 provides that

> "Patentability shall not be negatived by the manner in which the invention was made"

REASONS FOR GRANTING THE WRIT

Congress has recognized the importance of encouraging invention. The intention of Congress, to that end, has been made very evident by several recent legislative enactments.

One of these is the new Patent Act of 1952. Another is the tax statute, the Revenue Act of 1954. In Section 1235(a) of that tax statute, quoted in Appendix C, Congress has favored inventors, as distinguished from authors and composers, and the Congressional proceedings show that this was done designedly, in order to encourage inventors to invent.

This intention of Congress to encourage invention did not arise out of any solicitude for our large corporations. According to George E. Frost: "The Patent System And The Modern Economy", Study No. 2, U. S. Senate Subcommittee on Patents, Trademarks and Copyrights, of the Committee on the Judiciary, U. S. Senate, 84th Congress, Second Session, December 26, 1956, 77 pages, at page 77, the patent system aids the *little* business man, rather than the large corporations:

> Inventors were becoming discouraged by the administration of the patent laws, and one of the objects of that new Patent Act was to try to dispel that discouragement.

"Rather—through the operation of the patent system—the small company and the newcomer has been able to gain a foothold without being subject to appropriation of developments by the larger entrenched firms. Polaroid, Thiokol, Mallory, and many others, represent small and modest sized business which have launched new products against the competition of an existing industry * * * It should not be assumed that every time an excuse is found to invalidate a patent, competition somehow necessarily benefits."

The proper construction of Section 103 of the new Patent Act, which is described as "the fundamental law" in *Application of Ruff and Dukeshire*, 1958, C. C. P. A., 256 F. 2d 590, *supra*, at page 598, footnote 2, is of great concern, not only to patentees, but also to the country as a whole.

It is very important to obtain this Court's construction of the statute, for reasons that will now be explained.

The statute was enacted after many years of careful study of a number of previous drafts. Its present form was finally adopted, not because it was regarded as perfect, but only because there was no unanimous agreement, at the time, as to how it could be improved further.

In that finally adopted form, however, it was the hope of Congress, as stated in the Reviser's Note and as appears also from the statements by Mr. Federico, pages 89, *supra*, that "the statute may have some stabilizing effect" that is, that the statute would be construed in a friendly spirit. Congress considered that, if that hope could be realized, no further legislation would be needed.

Congress was nevertheless fearful, however, that some of our courts would still remain hostile. In that event, the Reviser's Note continued, it may become necessary, "at a later time", to enact amendatory legislation embodying "some criteria which may be worked out".

Congress is now again studying the problem, therefore,

with the object in view of perhaps enacting further legislation. In several reports, the Subcommittee has expressed dissatisfaction with the large number of patents that are still being invalidated by the Courts.

Further legislation would, however, become unnecessary if this Court would construe Section 103 as it was intended by Congress that it should be construed.

If this Court should decide so to construe Section 103 as to exclude from its scope inventions: first, as in the present case, for a dangling shoe ornament that both enhances the happiness of our feminine friends during walking and dancing (the District Court Judge Aldrich found, page 17, *infra*, that "Ladies appear to like this"), and also frees the shoemaker from the constant dread of sharp instruments penetrating the flesh and bones of his thumb and fingers; and, secondly (as in the case of the Stoffel Seals Corporation Petition for Certiorari, No. 361, *supra*, page 3), for an identification tag that, in addition to its other advantages, again adds to feminine happiness by eliminating their persistent complaints that the prior-art tags are difficult to remove from the fowl to which those prior-art tags are attached; then it will be important to have that construction as soon as possible.

Congress will then be called upon to decide whether to permit the patent law to retain this construction of Section 103, or whether, on the other hand, it should enact further legislation, in order again to try to dispel the discouragement of inventors.

In the former event, furthermore, Congress should now go further. It should abolish altogether the divisions of the Patent Office that are issuing patents for inventions relating to shoe ornaments, identification tags and many other devices that this Court will not sustain.

Congress should stop the appropriation of moneys that are being wasted in the processing of patents for inventions that are made, in good faith, by inventors who are deluded by the promise that these divisions of the Patent Office will approve patents for their inventions in shoe ornaments, identification tags and other products that promote the progress of the useful arts, which is the very purpose of the Constitutional provision, Article 1, Section 8; in reliance upon which promise they invest their treasure, their effort and even their very lives, after going into debt in the process, only to discover, in the end, that that promise does not have the sanction of this Court. (An excellent illustration is afforded by the struggles of the present petitioner, as recounted, for example at R. 152-157; at the end of those struggles, his only reward was that his competitors, the respondents herein, without spending a single cent of their own money in experimentation or development, have reaped the benefits of the progress in the useful arts that the plaintiff's efforts, money and thought has provided.)

Congress should make it impossible, any longer, for our future Eli Whitneys, our Morses, our Bells, our Westinghouses and our Edisons even to enter the Patent Office.

It is important also to resolve the conflict, referred to in the dissenting opinion of Judge Lumbard, in *E. J. Brooks Company* v. *Stoffel Seals Corporation*, *supra*, between this Court of Appeals for the First Circuit, in the present case on the one hand, and the Courts of Appeals for the Second, Third, Fourth and the District of Columbia Circuits, on the other; and, as a matter of fact, also between the panels of the Court of Appeals for the Second Circuit itself, as demonstrated by a comparison of the *Stoffel Seals Corporation* case, supra, which is now before this Court, Petition for Certiorari, No. 361, and *American Safety Table Company, Inc.* v. *Schreiber et al.*, 1959, 2 Cir., 122 U. S. P. Q. 29.

CONCLUSION

For the reasons stated, it is respectfully submitted that this petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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Further comments on this point may be found in Appendix E.

APPENDICES

Appendix A

The Opinion of the District Court

Bernard Glagorsky v. Boxcraft Trimming Co. et al., Judge Aldrich (R. 188), 164 F. Supp. 265:

(August 20, 1958.)

ALDRICH, D. J.

This is an action for infringement of Patent No. 2,792,656 in which both parties move for summary judgment. Neither questions the appropriateness of the procedure. George P. Converse & Co. v. Polaroid Corp., 1 Cir., 242 F. 2d 116, but they dispute the conclusions to be drawn.[1] The record is quite full, and I believe no useful purpose would be served by summarizing it all. The alleged invention consists of a small multi-pronged, ornamental stud, with an integral, peripheral ring or hook. The purpose of the prongs is to affix the stud to ladies' shoes or other articles which it is desired to decorate, and of the ring or hook to permit other decorative objects to be suspended from the stud in such a way that these latter ornaments will dangle loosely from the shoe, rather than be rigidly attached. Ladies appear to like this. ("With rings on her fingers and bells on her toes * * *" Mother Goose.) Plaintiff received his patent, with seemingly no great difficulty, on May 21, 1957. In the past two years his article has shown its usefulness and has enjoyed some measure of commercial success. Defendant's product is a clear, or patent, if I may be forgiven, imitation.[2] Its defense is invalidity.

No such article has ever previously been patented or manufactured for this precise purpose. Admittedly, the device is simple. Defendant says it is obvious. Plaintiff cautions me, as every patent judge who ever lived has been cautioned, against Monday-morning-quarterbacking.

---

[1] On the issue passed upon in this opinion there is no disputed testimony, and the parties have stated that nothing further would be offered in case of trial.

[2] Plaintiff describes it as a Chinese copy, an improper use of the term, as I believe a Chinese copy is one including unwanted imperfections, and no one suggests any here.

So much for this advice that sensitive judges may well hesitate to find even the most obvious to be obvious. I am not so troubled.

There is nothing new about ornamental studs attached by prongs, as such. Plaintiff's specifications contain no limitations as to the shape or composition (other than that they be integral) of the prongs. The only asserted invention is the inclusion of a peripheral, integral ring or hook. This is a mechanical, not a design, patent. Once it has been ascertained that women would like both studs and dangling objects on their shoes, it does not seem to me to require inventive genius to include on the stud a ring or hook to unite the two of them, any more than it does to add a hook to a breast-pin from which to suspend doodads, or eyeglasses, or, if you are an aborigine, to make a hole in your nasal cartilage from which to hang a ring. Perhaps this last is an overstatement, but I note that as early as Wardner No. 1,247,912, Nov. 27, 1917, an "ornamental vault," to use plaintiff's description of the head of a stud, was designed with an integral peripheral hook for the suspension of other objects.[1] Plaintiff seeks to distinguish Wardner on the ground that its purpose was principally utilitarian and only incidentally ornamental, but I am not impressed by such a difference of degree.[2] Nor, in the light of the art subsequent to Wardner should it be material that the Wardner "vault" was attached to the primary surface by a single spike instead of plaintiff's by prongs.

In short, in spite of whatever presumption plaintiff may be entitled to from the issuance of the patent,[3] I

---

[1] Note Reynolds, No. 460,161, Sept. 29, 1891. I do not pass on the validity of plaintiff's distinction that in Reynolds the ring was used to bend the studs itself, rather than to suspend something from the stud, but Reynolds is another illustration of the fact there is nothing [illegible] in a circular ring for attachment purposes.

[2] It is also a dangerous argument for plaintiff to make, because some of his contentions suggest that the stud with ring is invention for the very reason that it serves the utilitarian purpose of attaching light dangling ornaments. Plaintiff also suggests that Wardner was inoperative [illegible] if that was so it apparently was only because Wardner lacked foresight for its anticipated utilitarian aspect which plaintiff has at once.

[3] Although the Examiner concerned himself with distinguishing certain [illegible] as to which, frankly, I might be inclined to agree with him, [illegible] that Wardner was not cited), and failed to see the wood for the trees.

am unable to perceive invention. Defendants' motion for summary judgment is granted. It follows that plaintiff's must be denied.

ALDRICH,
U. S. D. J.

APPENDIX B

The Opinion of the Court of Appeals for the First Circuit

Bernard Glagovsky v. *Boxcraft Trimming Co., et al.* (R. 101), 267 F. 2d 479:

(June 5, 1959.)

WOODBURY, Circuit Judge.

This is an appeal from an order denying the plaintiff's and granting the defendants' motion for summary judgment in a suit for infringement of all five claims of United States Patent No. 2,792,656 for an "Ornamental Stud and Ornament Dangling Therefrom" issued to the plaintiff on May 21, 1957.

The first claim of Glagovsky's patent is for an "ornamental stud," generally known as a "nail head stud," which may be plain or ornamented and of any desired shape, as circular, square, diamond shaped, hemispherical, or pyramidal, having prongs attached to its periphery at right angles to its plate for penetrating the article to which the stud is to be attached and then clinched to hold the stud in place, the stud "being provided with an integrally projecting suspending fastening member from which any of a plurality of additional ornamental members may selectively be suspended to dangle freely." Claim 2 is identical with claim 1 but specifies that the integrally projecting fastening member is a ring; claim 3 specifies the fastening member to be a hook. Claim 4 is for the combination of the stud covered in claims 1, 2 and 3 with an ornament dangling from the fastening member of the stud. Claim 5 is for the combination described in claim 4 attached to "an article of wearing apparel." Although not so limited, the patented device was designed and is primarily intended for attachment to the uppers of women's shoes.

On the basis of affidavits, depositions and prior patents introduced as exhibits at the taking of the depositions

the District Court concluded that it was "unable to perceive invention" and therefore granted the defendants' motion for summary judgment and denied the plaintiff's. The prior art and the patent claims are so simple that they can be readily understood by any normally intelligent person without the aid of expert testimony. There was, therefore, no error below in disposing of the plaintiff's suit on the motions for summary judgment and their supporting affidavits, depositions and exhibits. *George P. Converse & Co. v. Polaroid Corp.*, 242 F. 2d 116, 120 (C.A. 1, 1957), and cases cited.

The defendants' infringement is freely admitted. Thus the only issue presented is whether the District Court's finding of invalidity for lack of invention can stand. We think that it certainly can.

The plaintiff-appellant invites us to reconsider our statement in *Wasserman v. Burgess & Blacher Co.*, 217 F. 2d 402, 404 (C.A. 1, 1954),[1] that § 103 of the Patent Act of 1952 quoted in material part in the margin [2] "merely codified the existing decisional law," and now hold that the section interpreted in its setting in the Act as a whole and in the light of its legislative history was intended by Congress to lower the standard of invention and put an end to its strict application as evidenced in numerous decisions handed down in recent years. We decline the invitation for we do not find this case an appropriate vehicle for the undertaking. Glagovsky's device impresses us as so lacking in invention that the claims of his patent cannot be sustained even by applying the now statutory standard as liberally and as generously to the patentee as the wording of the statute permits.

There is some question as to the "art" to which the subject matter of the patented device pertains. Does it lie in the art of wearing apparel generally, or in the shoemaking art? Or does it belong in the art of personal adornment or in the narrower art of pendant personal adornments? It has a certain affinity with objects in each

[1] See also *Hawley Products Co. v. United States Truck Co.*, 259 F.2d 69, 72 (C.A. 1, 1958).

[2] "A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

of the above "arts" without fitting definitely and exclusively into any one of them. We need not classify it in a particular art, however, for viewed against the background of any pertinent art it still does not seem to us to exhibit "that elusive something known as invention." *Hailey Products Co. v. United States Trunk Co.*, 259 F. 2d 69, 72 (C.A. 1, 1958).

The plaintiff does not claim a plain or ornamental nail head stud with peripheral prongs for attachment. It is conceded that such studs are old in many arts, specifically in the shoemaking art, where studs of that kind have been used for years to adorn the uppers of shoes. The heart of the plaintiff's patent is the integral ring or hook, in the usual embodiment stamped out of the same material as the stud on its periphery, from which the dangling ornament is suspended by a hook or ring attached thereto, the hook, whether it be part of the stud or part of the dangle, being bent together to provide permanent attachment of the two objects. But studs with peripheral integral rings or hooks for the attachment of dangling ornaments, either with or without peripheral prongs for attaching the stud, are not new. They have been used for years, as the plaintiff himself admitted on deposition, for ornamenting dresses, belts and the like. And prongless ornamental studs with peripheral rings from which to dangle additional ornaments have been well known in the jewelry art for a long time. See Patent No. 119,530 issued to Northup in 1871. The fact that the prongs used for attaching studs to a dress or light fabric were not made long or strong enough to pierce the leather used for the uppers of shoes is of no consequence, of course. Not only are the attaching prongs of the nail head stud no part of the patent but even if they were, it would be fair routine work for a mechanic to make the prongs suitable in length, shape and strength to pierce the leather used for shoe uppers.

In the shoemaking art, however, although nail head studs with ornaments dangling therefrom had been used for years, nail head studs having a peripheral, integral ring or hook for suspending the dangling ornament were not known prior to the disclosure of Glagovsky's patent. One method of the prior art of shoemaking, according to the specification of the plaintiff's patent, was to provide the additional ornament, the dangle, with a hook or

ring for its suspension and to secure it to the shoe upper by inserting one of the prongs of the ornamental stud through the hook or ring before clinching the prongs through the leather. A defect of this technique was that the suspended ornament did not dangle freely. Another prior art method was to suspend the dangle loosely from a small, thin, split, metal-wire ring, called a "split jump ring," or more simply, a "jump ring," threaded through the hook or ring of the additional ornament and then inserting a prong of the nail head stud through the jump ring before clinching. This technique allowed the ornament to dangle freely, but a disadvantage of the method was that the jump ring was likely to be damaged by being hit by a prong of the stud as it was forced through the leather with the result that the additional ornament would fall off either during manufacture or in use soon afterward. And both of these methods were difficult to practice for a certain amount of skill was required to hold the ornament or the jump ring attached to it in proper position under the stud as it was driven through the leather. Moreover operators were likely to have their fingers pinched in the process.

The plaintiff solved these problems. But he did so by adopting a device which, with only a mechanic's changes, had long been in use in the allied arts of wearing apparel other than shoes, *i.e.*, dresses and belts, and the jewelry art. And in the art of shoemaking all he did, in effect, was to attach a solid ring, for his purposes the equivalent of the split jump ring of the prior art, to the periphery of the old nail head stud instead of inserting a prong of the stud through the ring. The plaintiff's only meaningful contribution to the art of making shoes was to add an integrally projecting ring or hook to the old nail head stud from which to suspend the old additional ornament instead of suspending the ornament by inserting one of the prongs of the stud through a ring or hook attached to the ornament or through an additional jump ring. The plaintiff's advance may well be useful and ingenious. But making full allowance for the presumption that the patent is valid and placing the burden of establishing its invalidity on the defendant, 35 U.S.C. § 282, it does not seem to us that even in the light of the plaintiff's commercial success it can be said that the

plaintiff's contribution, viewed either against the background of the allied prior arts of wearing apparel and jewelry or against the background of the particular prior art of shoemaking, can be called an invention without defining that term to describe no more than the sort of advance to be expected from any ordinarily skillful mechanic conversant with any of the arts involved.

Other contentions of the plaintiff-appellant have been considered only to be rejected as too insubstantial to warrant discussion.

Judgment will be entered affirming the judgment of the District Court.

APPENDIX C

The Patent Act of 1952

Section 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious at the time the invention was made to *a person having ordinary skill in the art to which said subject matter pertains*. Patentability shall not be negatived by the manner in which the invention was made (italics supplied).

REVISER'S NOTE.

Section 103. New Section.

There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850,

referring to *Hotchkiss* v. *Greenwood*, 1850, 11 How. 248, 267.

This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect.

and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

Section 282. Presumption of validity; defenses.

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

. . . . . .

. . . . . .

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial of the * * * name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. * * *.

Internal Revenue Code, 1954

Sec. 1235. Sale or Exchange of Patents.

[Sec. 1235 (a)]

(a) GENERAL.—A transfer (other than by gift, inheritance, or devise) of property consisting of all substantial rights to a patent, or an undivided interest therein which includes a part of all such rights, by any holder shall be considered the sale or exchange of a capital asset held for more than 6 months, regardless of whether or not payments in consideration of such transfer are—

(1) payable periodically over a period generally coterminous with the transferee's use of the patent, or

(2) contingent on the productivity, use, or disposition of the property transferred.

Source: New.

APPENDIX D

Walker on Patents, Deller's Edition, 1937, Vol. I, Ch. III, "Invention", page 145, Section 28, reads:

> "But if a particular result was long desired and sometimes sought but never attained, want of invention cannot be predicated of a device or process which first reached that result, on the ground that the simplicity of means is so marked that many believe they could readily have produced it if required."

citing many cases from this and other Courts.

On a prior day, the Court of Appeals for the First Circuit itself said that "To obtain absolute simplicity is the highest trait of genius", *Decco Co. v. George E. Gilchrist Co.*, 1903 1 Cir., 125 F. 293, 298.

With respect to the law relating to new combinations of old elements, attention is invited to the title on page 117 of Walker:

> "New combination of old elements, producing new mode of operation and beneficial result, or producing new and beneficial result, never attained before, evidence of invention."

The text cites decisions of this and other Courts.

With respect to the law relating to non-analogous arts Walker says, on page 232:

> "It may be invention, to use an old process, machine, manufacture, composition of matter, or design, for a new and non-analogous purpose".

citing still further decisions of this and other Courts. In Application of Lobl, 1955, C. C. P. A., 228 F. 2d. 234, 237 for example, the following test was laid down:

> "It does not seem likely to us that one seeking to produce an improved closure for containers would look to the door buffer art for suggestions."

In the present instance, however, the District Court and the Court of Appeals have "looked for suggestions" of the plaintiff's invention to the arts of doorbells, eyeglasses, breast pins, hasp carriage decorations of aborigines and earrings.

APPENDIX E.

[illegible] Whitney's cotton gin was a typical socalled gadget [illegible] patent. It consisted, in brief, of only a piece of metal, provided with grooves to receive traveling wire teeth for separating the cotton from the seeds. That so-called gadget however revolutionized an industry and changed the course of history.

[illegible] pages 1 and 2 of a small booklet issued by the Western Union Telegraph Company, 60 Hudson Street, New York 13, N. Y., entitled, "The Story of Western Union"

[illegible] Morse first exhibited the telegraph before President [illegible] Buren, the Capitol building at Washington, D. C. Morse [illegible] Congress to back a crazy scheme. Morse tried [illegible] Congress to appropriate money for an [illegible] and finally his bill was passed [illegible] March 3, 1843.

The experimental line was completed for a year, but [illegible] Congress simply let the telegraph wither away. Congress would never spend enough money to [illegible] Morse then persuaded a skeptical public [illegible] stock and [illegible] the telegraph as a private [illegible] enterprise, [illegible] succeeded.

On December 16, 1929, the then Commissioner of Patents, [illegible] Coolidge P. Dec, testified before the Temporary [illegible] Committee of the Congress of the United States, Seventy-sixth Congress, First Session, which was conducting hearings in connection with an investigation [illegible] Concentration of Economic Power, Government Print[illegible]

ng Office, 1939. On page 812, referring to the pioneer tele-phone patent of Alexander Graham Bell, Mr. Coe remarked:

> If the Patent Office at that time had adopted that high standard of invention which excludes all things trivial, it would probably have refused the patent to Bell, since in its basic characteristic it is hardly more than *a toy which would fail to amuse a very young child* (italics supplied).

Confirmatory of the testimony of Commissioner of Patents Coe is the statement of Chauncey M. Depew, "My Memories of 80 Years", 1922, at page 351. He was offered a one-sixth interest in the whole telephone invention for the sum of only ten thousand dollars. He refused the offer, however, on the advice of "the best informed and most accomplished electrical expert in the country", who advised him: "There is nothing in this patent whatever, nor is there anything in the scheme itself, except *a toy*" (italics supplied).

The telephone was not alone to suffer this criticism. George Westinghouse's air brake, without which modern transportation would be impossible, received a similar expert opinion. In fact, it earned for him the appellation "Crazy George".

On page 198 of an article by Edmund Van Deusen, entitled, "The Inventor In Eclipse", Fortune Magazine, December, 1951, it is demonstrated that under so-called high standards of invention, Edison's lamp patent would have been invalidated.

In an address delivered on February 19, 1958, before the Cincinnati Patent Law Association, entitled, "Invention American Style", Journal of the Patent Office Society, Volume 40, No. 5, May, 1958, commencing at page 312, Judge Florence E. Allen of the United States Court of Appeals for the Sixth Circuit, said at page 320:

> Archimedes would have dismissed the pop-up toaster, the pressure cooker, and the thermostat frying pan, the electric range, the power mower, the infrared light, as being unworthy of high intellect; but they have enormously eased the pressure upon many a mother or father of a family * * *. And so the ordinary person has a fountain pen, an inexpensive watch, considers it not impossible to buy a typewriter, and fully intends to own a car * * *. I stress the homely achievements of American creative thought because they seem to me to carry out the American tradition.

On the previous page, Judge Allen said:

> Jefferson continually thought of accommodating machines "to the small and more numerous callings of life". He favored cheap, ingenious, small mechanical devices applicable to "our daily concerns".

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SUPREME COURT, U.S.
FILED
SEP 30 1959
JAMES R. BROWNING, Clerk

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1959

No. 369

BERNARD GLAGOVSKY,

Petitioner,

v.

COMCRAFT TELEPHONE CO.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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STATUTE

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Supreme Court of the United States

OCTOBER TERM 1959

BERNARD GLAGOVSKY,
Petitioner,
v.
BOWCRAFT TRIMMING CO. *et al.*,
Respondents.
No. 369

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

STATEMENT OF THE CASE

In this action for infringement of United States Patent No. 2,792,656 (R. 7) Defendants-Respondents and Plaintiff-Petitioner filed in that order motions for summary judgment. Although the patent is stated in the specification to be addressed primarily to satisfying the esthetic urge, it is a mechanical, not a design patent. On a record including depositions, affidavits and physical exhibits, both the District Court (R. 188, 164 F. Supp. 265) and the Court of Appeals for the First Circuit (R. 204, 267 F. 2d 479) found the patent invalid for lack of invention.

The Court of Appeals specifically rejected the present Petitioner's request to reconsider its previous position that Section 103 of the Patent Act of 1952* merely codified the existing decisional law, saying that this case was not "an appropriate vehicle for the undertaking" because the patent claims "cannot be sustained even by applying the now

* Set forth at page 23 of the Petition.

statutory standard as liberally and as generously to the patentee as the wording of the statute permits" (267 F. 2d 479, 481); saying also "it does not seem to us that even in the light of the plaintiff's commercial success it can be said that the plaintiff's contribution . . . can be called an invention without defining that term to describe no more than the sort of advance to be expected from any ordinarily skillful mechanic conversant with any of the arts involved." (267 F. 2d at 482). Nevertheless, Petitioner now asks this court to consider the same question.

ARGUMENT

There is no reason why the writ should be granted.

This is an ordinary patent case in which both courts below have found the patent invalid. Such concurrent findings are not to be set aside unless clearly erroneous.

Although Petitioner has attempted to show that this is a case involving unsettled or disputed questions of law and conflicts in decision with other circuits, the facts show that this is not so. There is not here any question of general interest or public importance calling for the grant of certiorari.

No question regarding the proper interpretation of the Patent Act of 1952 arises in this case.

Petitioner's Questions I and II refer to Section 103 of the Patent Act of 1952 as in effect interdicting a decision holding that the patent in suit or, for that matter, any patent,* is invalid.

In presenting these questions, as well as elsewhere in the Petition (pp. 3, 11) Petitioner refers to Petition for

* See page 15 of the Petition.

Certiorari No. 361, in *Stoffel Seals Corporation* v. *E. J. Brooks Company*, which is a case in another circuit on an entirely different patent wherein the facts are entirely different from the ones in the case here presented. We see no relevance in that case and no reason why the decision of this Court as to whether or not to issue a writ in the *Stoffel* case would have any bearing on its decision in the instant matter.

Petitioner couches its petition in language which might imply that the courts below held the patent in suit invalid because the combination in question is "simple" (Petition, pp. 3, 5). Thus, at page 5 the Petition states "The District Court and the Court of Appeals . . . both found the invention, however, to be 'simple'; and, therefore . . . 'obvious'." Actually, the courts below merely followed the suggestion of the parties as set forth in a footnote on page 6 of the Petition, that the simplicity of the subject matter made the case one suitable for adjudication by summary judgment and that no expert testimony was needed to help those courts understand the patent. Nevertheless, Petitioner's Question II deplores the absence from the proceedings of the person "having ordinary skill in the art. . . ."

The Courts below did not find lack of invention because of simplicity, nor did they overlook any presumptions to which the patentee is entitled. As the Court of Appeals said:

> "The prior art and the patent claims are so simple that they can be readily understood by any normally intelligent person without the aid of expert testimony. There was, therefore, no error below in disposing of the plaintiff's suit on the motions for summary judgment and their supporting affidavits, depositions and exhibits." (267 F. 2d at 480)

The court correctly found that "The heart of the plaintiff's patent is the *integral* ring or hook . . . from which

the dangling ornament is suspended. . . . " (267 F. 2d at 481); (emphasis supplied). The court realized that "nail head studs having a peripheral, *integral* ring or hook for suspending the dangling ornament were not known prior to the disclosure of Glagovsky's patent." (267 F. 2d at 481) and went on to find correctly that:

> "The plaintiff's only meaningful contribution to the art of making shoes was to add an integally projecting ring or hook to the old nail head stud from which to suspend the old additional ornament instead of suspending the ornament by inserting one of the prongs of the stud through a ring or hook attached to the ornament or through an additional jump ring."

The court continued:

> "The plaintiff's advance may well be useful and ingenious. But making full allowance for the presumption that the patent is valid and placing the burden of establishing its invalidity on the defendant, 35 U. S. C. 282, it does not seem to us that even in the light of the plaintiff's commercial success it can be said that the plaintiff's contribution, viewed either against the background of the allied prior patents of wearing apparel and jewelry or against the background of the particular prior art of shoemaking, can be called an invention without defining that term to describe no more than the sort of advance to be expected from any ordinarily skillful mechanic conversant with any of the arts involved."

So far as the interpretation of Section 103 of the Patent Act of 1952 is concerned, the court said:

> "The plaintiff appellant invites us to reconsider our statement in Wasserman v. Burgess & Blacher Co., 217 F. 2d 402, 404 (C. A. 1, 1954), that '103 of the Patent Act of 1952 quoted in material part in the margin 'merely codified the existing decisional law,' and now hold that the section interpreted in its setting in the Act as a whole and in the light of its legislative history was intended by Congress to

> lower the standard of invention and put an end to its strict application, as evidenced in numerous decisions handed down in recent years. We decline the invitation for we do not find this case an appropriate vehicle for the undertaking. Glagovsky's device impresses us as so lacking in invention that the claims of his patent cannot be sustained even by applying the now statutory standard as liberally and as generously to the patentee as the wording of the statute permits." (267 F. 2d at 480)

Thus, it is clear that the courts below found lack of invention by any standard. This case would, therefore, appear not to be a proper one for use in deciding whether the First Circuit properly construed the Patent Act of 1952 and there is no justification for the granting of certiorari by this court.

Moreover, there is no clear showing that there is diversity of results among the circuits due to differences in the interpretation of § 103. To quote from Judge Lumbard's dissenting opinion in *E. J. Brooks Company v. Stoffel Seals Corporation*, 266 F. 2d 841, 846 (2nd Cir., 1959):

> "As Judge Kalodner pointed out for the Third Circuit, sitting *en banc* in R. M. Palmer Co. v. Linden's Inc., 1956, 236 F. 2d 496, 500, whether the 1952 amendments were a codification rather than a change in existing law depends entirely on what view any particular circuit had taken prior to 1952."

So far as the present record shows, the First Circuit's understanding of the present state of the law as regards invention is precisely that indicated by Congress when it enacted § 103.

CONCLUSION

It is respectfully requested that the Petition be denied because the record does not present a case calling upon this court to exercise its supervisory powers.

There is no unsettled or disputed question of law or any conflict of decision with any other circuit and no question of general interest or public importance arising from the facts of this case calling for the grant of certiorari.

Respectfully submitted,

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Office-Supreme Court, U.S.
FILED
OCT 10 1959
JAMES R. BROWNING, Clerk

Supreme Court of the United States

October Term, 1959

No. 369

BERNARD GLAGOVSKY,
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BOWCRAFT TRIMMING CO. ET AL.,
RESPONDENTS.

PETITIONER'S REPLY BRIEF

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No. 369

BERNARD GLAGOVSKY,

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V.

BOWCRAFT TRIMMING CO. ET AL.,

RESPONDENTS.

PETITIONER'S REPLY BRIEF

I.

The demonstration, on page 9 and at the bottom of page 15 of the petition, of hopeless conflict among the Courts of Appeals relating to the proper construction of Section 103 of the Patent Act of 1952 is regarded in the "Respondents' Brief In Opposition To Petition For Writ Of Certiorari", as constituting "no clear showing that there is diversity of results".

If, therefore, that "showing" has not been sufficiently "clear" heretofore, it has since become *thoroughly* "clear". As emphasizing the hopelessness of this conflict, reference may now be made to a recent additional Petition for Certiorari, No. 128, *Columbia Boiler Co., Inc.* v. *Manville Boiler Co., Inc.*, and to the still additional divergence of opinions in *Talko Brothers Slate Co., Inc.* v. *Hannon*, September 11, 1959, 2 Cir., 122 U. S. P. Q. 585.

The Court of Appeals for the First Circuit is in accord with the majority opinion in this *Tatko* case, but is out of harmony with the dissenting opinion and with the Court of Appeals for the Fourth Circuit in the *Columbia Boiler Co.* case.

Since writing the above, the attorneys for the petitioner have been informed by counsel that they are in process of preparing, and will promptly file, a petition for certiorari in *American Safety Table Company, Inc.* v. *Schreiber et al.*, 1959, 2 Cir., 269 F. 2d 255, 122 U. S. P. Q. 29, referred to at the bottom of page 15 of the present petition.

II.

The Respondents' Brief admits that "The Court of Appeals specifically rejected the present Petitioner's request to reconsider its previous position that Section 103 of the Patent Act of 1952 merely codified the existing decisional law."

In particular, the Court of Appeals refused to pass upon whether the following provisions, not all of which, certainly, were included in "the existing decisional law", and which were specifically introduced into the statute for the very purpose of emphasizing their importance, may now deliberately be read out of that statute, as though they had never been included therein:

I. The words "as a whole";

II. The words "a person having ordinary skill in the art to which said subject matter pertains"; and

III. The sentence "Patentability shall not be negatived by the manner in which the invention was made".

By his Questions I, II and III, therefore, the petitioner is requesting this Court to make the *same* rulings that the Court of Appeals refused to make.

The Respondents' Brief makes specific reference to Questions I and II, but it does not even mention Question III, at all.

III.

Question II was answered, however, as recently as September 11, 1959, in the dissenting opinion of Judge Madden, of the Court of Claims, *Tatko Brothers Slate Co., Inc.* v. *Hannon*, 2 Cir., 122 U. S. P. Q. 585, *supra*, at page 588:

> "The case seems to me to be getting itself decided, not on the basis provided by precedent and recent statute, of obviousness to those in the industry, but *of obviousness to the judges* after the patent has disclosed the device and the industry has adopted it. This seems to me to be a failure by the Court to adjust itself to the purpose and spirit, the 'mood', see Universal Camera Corp. v. Labor Board, 340 U. S. 474, 487, of Section 103 of Title 35 United States Code, enacted in 1952.
>
> The patent here in question was not a great patent. It required no Franklin, Faraday, Edison, or Marconi to conceive it. But the device was highly useful; it was admittedly new, and on its modest level, it was, I venture to say for myself, ingenious.[1] I think it was worthy of a valid patent, which the courts should protect" (italics supplied).

IV.

On pages 14-15, and in Appendix E, pages 26-28, of his petition, the petitioner has asked this Court to rule whether only inventions made by Franklins, Faradays, Edisons and Marconis are worthy of patent protection.

The present invention is illustrative of many that are of great importance, despite the fact that they are not contributed by our Franklins, Faradays, Edisons or Marconis. The opening paragraph of the Respondents' Brief, for example, to the effect that this invention is "addressed primarily to satisfying the esthetic urge", ignores the fact that it solves a long existent problem, and that it has now eliminated the

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[1] This word "ingenious" is the identical word used by the Court of Appeals for the First Circuit to describe the patentee's invention (see Petition, page 22, line 5 from the bottom).

danger of sharp instruments puncturing the thumb and fingers of the operator, as described in footnote 2, page 5, of the petition. It is submitted that this Court should encourage the making of inventions that reduce the number of accidents. Accidents actually take a greater toll of life and limb than do our wars.*

V.

Judge Madden also asked a question therefore similar to that which was asked in *Pope Appliance Corporation* v. *Spanuk River Pulp and Paper Mills Ltd* (1929), Reports of Patent, Design, Trade Mark, and Other Cases, vol. 46, page 25, at page 55, referred to in footnote 2, page 5, of the petition.

VI.

The respondents are not quite correct in stating that the District Court and the Court of Appeals, in this case, did not base their decision upon the ground that the invention was simple and, therefore, obvious. The District Court, for example, said (Petition, page 17a): "Admittedly, the device is simple. Defendant says it is obvious"; and the Court of Appeals approved.

VII.

There is a parallel with respect to this matter also in the said dissenting opinion of Judge Madden. He referred to a comment of the District Court, *Vermont Structural Slate Co.* v. *Tatko Brothers Slate Co.*, 1955, D. C. N. D. N. Y., 134 F. Supp. 4, at page 5. The same invention that Judge Mad-

* It would have been impossible, moreover, under our laws, to protect this invention by a design patent, either from the aesthetic point of view or from the point of view of safety to the thumb and fingers of the operator.

den, as quoted above, found to be "ingenious" and "worthy of a valid patent" was pronounced by that District Court as "one of unbelievable simplicity"; and the Court of Appeals for the Second Circuit, the same as the Court of Appeals for the First Circuit, in the present case, approved this description relating to simplicity as equivalent to obviousness.

The Respondents' Brief is not quite correct in saying that, in the Petition for Certiorari, No. 361, *Stoffel Seals Corporation* v. *E. J. Brooks Company*, "the facts are entirely different from the ones in the case here presented". Attention is invited to the bottom of page 3 and the bottom of page 11 of the petition in this case.

VIII.

The present invention, though "simple", is nevertheless "ingenious". It does, as the respondents say, satisfy "the esthetic urge"; It also, however, has entirely eliminated a source of danger to the thumbs and fingers of the operators, at the shoe factory. It was

I. new, "as a whole", and

II. not "obvious * * * to a person having ordinary skill in the art to which said subject matter pertains."

It was the intention of Congress, therefore, when it enacted the Patent Act of 1952, that this invention should have patent protection; and this irrespective of

III. "the manner in which the invention was made."

The decisions of a number of Courts of Appeals and of dissenting judges agree with this interpretation of the said Section 103.

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* It may be well to invite the attention of this Court once more to the fact that the Court of Appeals for the First Circuit described the petitioner's "simple" invention as also "ingenious".

As before stated, though the Respondents' Brief does touch upon Questions I and II it is entirely silent with respect to Question III.

The Court of Appeals for the First Circuit, on the other hand, disagrees with this interpretation.

It is submitted that this Court ought now to resolve this conflict.

IX.

It is therefore respectfully submitted that the petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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October 9, 1959